

In re Patent Application of:
DELVECCHIO ET AL.
Serial No. **10/628,623**
Filing Date: **JULY 28, 2003**

REMARKS

The Examiner is thanked for her thorough examination of the present application and for correctly indicating the allowability of the subject matter of dependent Claims 4, 8, 11, 14, 18, 21, 28, 32, 35 and 38. The amendments to independent Claims 25 and 33 are explained below, along with a detailed explanation of the patentability of the rejected claims.

I. The Amended Claims 25 and 28 Overcome the 35 U.S.C. § 112 Rejection and the 37 C.F.R. § 1.75(c) Objections

Independent method Claims 25 and 33 were rejected under § 112 as being non-enabled single step claims. The Examiner cited to *In re Hyatt*; however, it is respectfully pointed out that *In re Hyatt* considered a single element means plus function claim in contrast to the method claims of the present application. Nevertheless, to advance prosecution and also address the Examiner's Rule 1.75(c) objections, independent Claim 25 has been amended to recite that the method is to assist a user in reciting and learning prayers associated with a rosary. Support for this can be found at [0007], for example.

Claim 25 has further been amended to recite the additional step of providing a rosary including a flexible elongate member, a plurality of beads carried thereby, at least one sensor, and an audible indicator connected to the at least one sensor. In addition, Claim 25 has also been amended to recite that generating an audible indication from the audible indicator based upon the at least one sensor is done

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to thereby assist the user in reciting and learning prayers associated with the rosary.

These amendments to independent method Claim 25 not only address the Examiner's single step rejection under § 112, but also address the Examiner's objections under Rule 1.75(c) as the dependent Claims 26-28 are directed to modification of the first recited step in independent Claim 25 of providing the rosary with the recited structure.

Independent method Claim 33 has been similarly amended to Claim 25. Method Claim 33 now recites that it is a method to assist a user in reciting and learning prayers associated with a rosary. The method comprises providing a rosary comprising a flexible elongate member and a plurality of beads carried thereby, the flexible member being arranged in a loop and with a leg extending outwardly therefrom, the rosary further comprising at least one sensor, and a visual indicator connected to the at least one sensor and carried at a junction between the loop and the leg. The method also include generating the visual indication from the visual indicator based upon the at least one sensor to thereby assist the user in reciting and learning prayers associated with the rosary.

These amendments to independent method Claim 33 also not only address the Examiner's single step rejection under § 112, but also address the Examiner's objections under Rule 1.75(c) as the dependent Claims 34-35 are directed to modification of the first recited step in independent Claim 33 of providing the rosary with the recited structure.

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II. The Claimed Invention

The invention is directed to a rosary providing audible and/or visual indication to assist a user in reciting and learning prayers associated with the rosary. More particularly, independent Claim 1, for example, recites a flexible elongate member and a plurality of beads carried thereby, at least one sensor, and an audible indicator carried by the flexible elongate member for providing an audible indication based upon the at least one sensor. Independent device Claim 16 is similar, but is directed to the visual indication, and recites a visual indicator carried by the flexible elongate member at a junction between the loop and the leg for providing a visual indication based upon the at least one sensor.

Independent method Claim 25 is a method counterpart to independent device Claim 1, and independent method Claim 33 is a method counterpart to independent device Claim 16. These method claims are discussed more fully in Section I. above.

III. The Claims Are Patentable

The Examiner rejected independent Claims 1, 16, 25 and 33 over the combination of Wexler and Castellano. The Wexler Publication is directed to a hand-held rosary prompter in the form of a rigid circular case sized to be handheld and illustratively suspended from a neck chain. The hand-held rosary prompter case has ten lobes, each carrying a respective LED. Upon user contact with a switch centered at the front of the case, an audible portion of a prayer is output from a

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speaker to prompt the user to recite the remaining portion of the prayer.

The Examiner correctly notes that the Wexler Publication fails to disclose a flexible elongate member and a plurality of beads carried thereby, and looks to the Catellano patent to provide such. The Catellano patent discloses a rosary including a chain with five decades of beads separated by four spaced beads as in a conventional chain or string and bead rosary. The chain connects to a medallion and in-turn to a crucifix. The medallion includes a pair of respectively rotating plates about a pivot point. The plates are to be rotated away from an overlap position by the user to reveal prayer information (Col. 2, lines 46-50).

The Examiner contended it would have been obvious to modify the Wexler chain with a more traditional style chain and bead rosary as taught by Catellano to maintain the traditional feel and appearance of the rosary.

Applicants respectfully submit that the proposed selective combination of Wexler and Castellano is improper because the Wexler hand-held rosary prompter already prompts and tracks the same rosary prayers via the rigid case and lobes as do the Catellano chain and beads. In other words, it would be redundant and unduly complicated to replace the simple carrying chain of the Wexler prompter with a chain and bead rosary -- especially given that the Wexler prompter already provides the full functionality of the chain and bead rosary. Accordingly, one of ordinary skill in the art would be taught away from substituting the chain and beads as in Catellano for the simple neck carrying chain of Wexler.

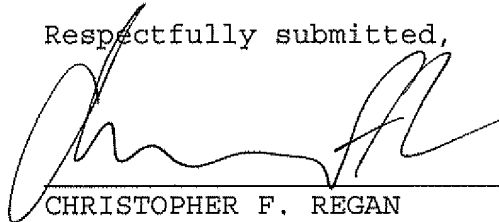
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The Examiner has impermissibly used the teachings of Applicants' own specification as a template in an attempt to selectively combine disjoint pieces of the prior art Wexler and Castellano references. It is therefore submitted that independent Claims 1, 16, 25 and 33 are patentable over the prior art. Their respective dependent claims, that contain yet further distinguishing features are also patentable, and require no further discussion herein.

IV. Conclusions

In view of the amendments to the claims and the arguments presented herein, it is submitted that all of the claims are patentable. Accordingly, a Notice of Allowance is respectfully requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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